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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/826,074	04/15/2004	Tilman Herberger	57616/03-262	9986
22206 7590 08/01/2008 FELLERS SNIDER BLANKENSHIP BAILEY & TIPPENS THE KENNEDY BUILDING 321 SOUTH BOSTON SUITE 800 TULSA, OK 74103-3318				
EXAMINER				
VU, THANH T				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/826,074

Applicant(s)

HERBERGER ET AL.

Examiner

THANH T. VU

Art Unit

2175

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 9-15 and 17-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 9-15, and 17-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 02/21/2008 has been entered.

This communication is responsive to Amendment, filed 02/21/2008.

Claims 1-6, 9-15, and 17-20 are pending in this application. In the Amendment, claims 7, 8, and 16 were cancelled, claims 18-20 were added, and claims 1, 9, and 15 were amended.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 18, and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "said video transition" in line 16. There is insufficient antecedent basis for this limitation in the claim.

Claim 18 recites the limitation "said video transition effect" and "said video transition" in line 21 and 23. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, 9-15, and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Foote et al. ("Foote", U.S. Pat. No. 2003/0160944) and Ubillos (U.S. Pat. No. 5,999,173).

Per claim 1, Foote teaches a method of aligning a video work with an audio work, wherein said audio and video works are configurable to be played in concert with each other, comprising the steps of:

a. automatically selecting a plurality of audio markers in said audio work, each of said selected audio markers having an audio time of occurrence associated therewith (figs. 1 and 2; *change detect 120*; [0037]);

b. identifying at least one video marker within said video work, each of said identified video markers having a video time of occurrence associated therewith (figs. 1-3; *change detect 115*; [0034]);

c. selecting one of said identified video markers and said video time of occurrence associated therewith (figs. 1 and 3; [0039]; [0042]);

d. selecting a video transition effects to apply at said selected video marker (figs. 1 and 3; [0056]; *which adjusting of video segment to fit the audio segment by inserting a title or graphic*);

e. automatically selecting one of said plurality of audio markers, wherein said time of occurrence of said selected audio marker is proximate to said video time of occurrence of said selected video marker (figs. 4-7; [0051]);

f. automatically synchronizing said video transition with said selected audio marker (figs. 4-7 *show aligning of video and audio data*; in addition see, [0051]-[0057]);

g. applying said synchronized video transition to said video work proximate to said video marker, thereby creating an aligned video work (figs. 4-7; [0051]); and,

h. storing said aligned video work on a computer readable medium ([0074]).

Although Foote teaches selecting a video transition effects to apply at said selected video marker (figs. 1 and 3; [0056]; *which adjusting of video segment to fit the audio segment by inserting a title or graphic*), and automatically synchronizing said video transition effect with said selected audio marker by altering video segments to fit the audio segment such as inserting a title or graphic (figs. 4-7 *show aligning of video and audio data*; [0051]-[0057]), Foote does not specifically teach adjusting a time duration of said video transition effect. However, Ubillos teaches selecting a video transition effect to apply to a selected video and adjusting a time duration of said video transition effect (col. 8, lines 26-37; col. 11, lines 35-50; *user can select video transition effect to include in a video work and adjust a time duration of said video transition (i.e. adjust "in" and "out")*). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include the teaching of Ubillos in the invention of Foote in order to allow a user to select special effects for inclusion into the final music video.

Per claim 2, the modified Foote teaches a method of aligning a video work with an audio work according to Claim 1, wherein step (a) comprises the steps of: (a1) selecting at least one audio criterion wherein each of said selected at least one audio criterion at least comprises a rule for identifying change points within said audio work (Foote, [0037], [0038]), (a2) using at least one of said selected audio criteria to identify at least two change points within said audio work

(Foote, [0037], [0038])), (a3) selecting a plurality of said at least two identified change points, thereby identifying a plurality of audio markers within said audio work (Foote, figs. 3-7; ([0056]; [0063])).

Per claim 3, the modified Foote teaches a method of aligning a video work with an audio work according to Claim 1, wherein step (a) comprises the steps of:

(a1) selecting a plurality of audio criteria, wherein each of said selected audio criteria at least comprises a rule for identifying change points within said audio work, (a2) assigning a priority to each of said selected audio criteria (Foote [0037],[0038]), (a3) selecting a highest priority audio criterion from among said plurality of audio criteria according to said provided priority ordering,(a4)using said selected audio criterion to identify at least two change points within said audio work, (a5) selecting a plurality of identified change points, thereby identifying a plurality of audio markers within said audio work (Foote, figs. 3-7; ([0056]; [0063])).

Per claim 4, the modified Foote teaches a method of aligning a video work with an audio work according to Claim 1, wherein step (e) comprises the steps of:

(e1) choosing one of said plurality of audio markers, wherein said time of occurrence of said selected audio marker is proximate to said video time of occurrence of said video marker (Foote , figs. 4-7 *show aligning of video and audio data*; in addition see, [0054]; [0056]; [0063]),

(e2) determining from a provided criterion for determining whether an audio marker is suitable for use with a selected video marker whether said chosen audio marker is suitable for use with said selected video marker (Foote, figs. 4-7; [0054]; [0056]; [0063]),

(e3) if said chosen audio marker is determined to be suitable for use with said selected video marker, selecting said chosen marker (Foote, figs. 4-7; [0054]; [0056]; [0063]),

(e4) if said chosen audio marker is determined not to be suitable for use with said selected video marker according to said criterion, performing steps (e1) through (e3) until either one of said chosen audio markers is found to be suitable or until all of said plurality of audio markers have been chosen (Foote, figs. 4-7; [0054]; [0056]; [0063]) and,

(e5) if after performing steps (e 1) through (e4) none of said plurality of audio markers is suitable for use with said selected video marker, taking no further action with respect to the selected video marker (Foote, figs. 4-7 *show aligning of video and audio data*; in addition see, [0054]; [0056]; [0063]).

Per claim 5, the modified Foote teaches a method of aligning a video work with an audio work according to Claim 1, comprising the further steps of: (i) reading said stored aligned video work from said computer readable media; and (j) playing said aligned video work on a display device ([0074]).

Per claim 6, the modified Foote teaches a method of aligning a video work with an audio work according to Claim 1, wherein said computer readable medium is selected from the group consisting of computer RAM, non-volatile RAM, magnetic disk, a RAM card, optical disk, magneto-optical disk, and a floppy disk ([0074]).

Claim 9 is rejected under the same rationale as claim 1.

Per claim 10, Foote teaches a method of aligning a video work with an audio work according to Claim 9, further comprising the step of: i. writing said aligned video work and said audio work to a computer readable medium ([0074]).

Per claim 11, Foote teaches a method of aligning a video work with an audio work according to Claim 10, wherein said computer readable medium is selected from the group

consisting of computer RAM, non-volatile RAM, magnetic disk, a RAM card, optical disk, magneto-optical disk, and a floppy disk [0074]).

Claims 12-14 are rejected under the same rationale as claims 2-4 respectively.

Per claim 15, the modified Foote teaches the method according to Claim 9, wherein step (d) comprises the steps of: (dl) selecting a video transition to apply at said selected video marker, said selected video transition having at least one transition parameter associated therewith, wherein said at least one transition parameter comprises a transition starting time and a transition ending time (Ubillos, col. 8, lines 26-37; col. 11, lines 35-50; *user can select video transition having starting time "in" ending time "out"*) and wherein step (f) comprises the step of:

(fl) synchronizing said video transition with said selected audio marker by modifying at least one of said transition starting time and said transition ending time (Ubillos, see fig. 3, col. 8, lines 25-37).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include the teaching of Ubillos in the invention of Foote in order to allow a user to select special effects for inclusion into the final music video.

Per claim 16, the modified Foote teaches the method according to Claim 9, wherein said video transition is a video effect (Ubillos, col. 11, lines 45-50).

Per claim 17, the modified Foote teaches A method according to Claim 16, wherein said video effect is selected from a group consisting of a wipe, a fade, a cross fade, a zoom in, a zoom out, a push, an overlap, and an iris dilation (Ubillos, col. 11, line 56-60).

Claim 18 is rejected under the rationale of claims 1 and 3.

Claims 19 and 20 are rejected under the rationale of claims 1 and 3.

Response to Arguments

Applicant's argument is that " a rejection under § 103(a) is only proper if there is a "teaching, suggestion, or incentive supporting the combination" relied upon. In re Geiger, 815 F.2d 868, 2 USPQ 2d 1276, 1278 (Fed. Cir. 1987)".

The examiner does not agree for the following reasons:

The Supreme Court Stated that the Federal Circuit had erred when it applied the well-known teaching-suggestion-motivation (TSM) test in an overly rigid and formalistic way. Specifically, as the Supreme Court pointed out, the Federal Circuit had erred in four ways:

- (1) "by holding that courts and Patent examiners should look only to the problem the patentee was trying to solve;"
- (2) by assuming "t hat a person of ordinary skill attempting to solve a problem will be led only to those elements of prior art designed to solve the same problem;"
- (3) by concluding " that a patent claim cannot be proved obvious merely by showing that the combination of elements was 'obvious to try;'" and
- (4) by overemphasizing "the risk of court and patent examiners falling prey to hindsight bias" and as a result applying "rigid preventative rules that deny fact finders recourse to common sense." KSR, 82 USPQ2d at 1397.

In the present case, the combination of Foote and Ubillos is obvious to one of ordinary skilled in the art because it allows a user to select special effects for inclusion into the final music video.

In addition, applicant primarily argues the followings:

"The cited passages of Ubillos merely reflect the well- known fact that a transition effect can be used to smooth the changes between adjacent video clips and in no way suggests applicants' approach of using transitions to synchronize audio and video works", "Nothing in Foote's algorithm suggests how to accommodate a variable length transition - Foote is exclusively focused on matching one point with another point", "Nowhere within Foote is there a teaching or

suggestion regarding the selection, use and application of video transition effects inserted into a video work, wherein one or more of the parameters of these transition effects will be modified in order to synchronize the breaks in the video work with the "markers" in the audio work", and "nowhere in Foote is there a description or suggestion of the step of applying said synchronized video transition to said video work, by at least adjusting said video transition effect with said selected audio marker" (page 21 and 22 of Remarks).

The examiner does not agree for the following reasons:

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In this case, Foote teaches selecting a video transition effects to apply at said selected video marker (figs. 1 and 3; [0056]; *which adjusting of video segment to fit the audio segment by inserting a title or graphic (i.e. video effect)*), and automatically synchronizing said video transition effect with said selected audio marker by altering video segments to fit the audio segment such as inserting a title or graphic (figs. 4-7 *show aligning (i.e. synchronizing) of video and audio data*; [0051]-[0057]), and Ubillos teaches selecting a video transition effect to apply to a selected video and adjusting a time duration of said video transition effect (col. 8, lines 26-37; col. 11, lines 35-50; *user can select video transition effect to include in a video work and adjust a time duration of said video transition (i.e. adjust "in" and "out")*). Thus the combination of Foote and Ubillos teach the claimed language of "automatically synchronizing said video

transition effect with said selected audio marker by only adjusting a time duration of said video transition effect”

Inquiries

Any inquiry concerning this communication or earlier communications from the examiner should be directed to THANH T. VU whose telephone number is (571)272-4073. The examiner can normally be reached on Mon- Fri 7:00 AM - 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William L. Bashore can be reached on (571) 272-4088. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Thanh T. Vu/
Primary Examiner, Art Unit 2175